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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,339	04/01/2004	Julio A. Abusleme	108910-00128	5351

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WASHINGTON, DC 20036

EXAMINER
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ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/814,339

Applicant(s)

ABUSLEME ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Rejection of claim 12 under 35 USC 112, first paragraph is withdrawn in view of the arguments filed by the applicants on 2-15-2006.

### ***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 6,107,393 to Abusleme et al', (hereinafter "Abusleme") or US PreGrant Publication 2001/0003124 to Zolotnitsky et al., (hereinafter "Zolotnitsky").

The rejection of claims 1 and 13 stands as per reasons set forth in the previous office action.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 2, 3 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zolotnitsky and Abusleme.

The rejection stands as per reasons of record. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zolotnitsky or Aabusleme in combination with Encyclopedia of Polymer Science and Engineering. Additives, (Hereinafter "Encyclopedia").

The rejection of claim 4 over the combined teachings of the above cited references stands as per reasons of record.

Claims 5-11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zolotnitsky or Aabusleme in combinations with Encyclopedia and US Patent 4,304,713 to Perelman (hereinafter "Perelman") or US Patent 5,688,457 to Buckmaster et al., (hereinafter "Buckmaster").

The rejection of claims 5-11 and 16-17 over the combined teachings of the above cited references stands as per reasons of record.

### ***Response to Arguments***

Applicant's arguments filed 2-15-2006 have been fully considered but they are not persuasive. The gist of applicants arguments regarding Zolotnitsky and Abusleme references is that the claimed invention is directed to "a E/CTFE polymeric composition comprising polymers of ethylene (E) and chlorotrifluoroethylene..." (see page 2, second paragraph of the applicants' response, emphasis original).

This statement is simply **not commensurate in scope** with the claimed invention. While the claimed subject matter is, indeed, called "a polymeric composition", the claims clearly read on the polymeric compositions containing only ONE polymer, namely CTFE polymer. The presence of the E polymer is OPTIONAL, as per claim language of the base claim 1, and NONE of the subsequent dependent claims require the presence of the E polymer (with the arguable exception of claim 12, where the

second polymer, arguendo, may be formed inherently from the claimed process. Note that it is an arguable exception.)

The applicants argue that both Abusleme and Zolotnitsky disclose a polymer of E, CTFE and a hydrogenated monomer, and that the polymer of Abusleme or Zolotnitsky do not anticipate the claimed "composition of polymers" of E and CTFE. Once again, this argument is not persuasive as not being commensurate in scope with the claimed invention. The claimed invention does NOT claim a "composition of polymers" as discussed above, rather it claims a polymeric composition necessarily containing only ONE copolymers of E and CTFE. (Further, in this regard the applicant should further note that any polymer is, in fact, a polymeric composition by itself since a polymer always contains number of polymer that can be distinguished based on molecular weights, and, in case of copolymers, necessarily, based on the exact composition of different polymer chains.)

The applicants further argue that Abusleme does not teach obtaining a polymer having the same electrical properties of the homopolymer PCTFE and showing no brittle behavior because the reference is concerned with solving another problem, i.e., to improve affinity with the hydrogenated plasticizers. While it is true that the invention of Abusleme is concerned with solving of another technical problem, the reference still discloses the polymers that are not patentable distinguishable from the claimed polymers. Simply because the reference is silent with respect of some properties of the disclosed polymers does not mean that the properties are not inherently exhibited by the disclosed polymers. It has been long established by the courts that "[T]he

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discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). In the instant case, there is nothing on the record that provides evidence of unexpected behavior of the claimed polymer over the polymers disclosed by Zolotnitsky or Abusleme and which, as per expressed disclosure of both references, can contain as little as 0.1 % of hydrogenated monomer and as little as 10 % of ethylene.

The applicants further argue that the examiners position that the copolymers containing 10 % of ethylene as per expressed disclosure of Abusleme and Zolotnitsky inherently exhibit the claimed TmII is untenable since the applicants provided evidence in Example 4 and Comparative example 10 that the ECTFE polymer has a lower TmII as compared to the composition containing ECTFE (and CTFE polymer). Once again, the applicants argue the features that are not necessarily claimed in the claims. The claims do NOT require a composition of two compositionally different polymers. All the properties of the COMPOSITIONS containing two different polymers, namely E/CTFE and CTFE discussed and relied upon by the applicants that are irrelevant as not commensurate in scope with the claimed invention. It is noted that the polymer of illustrative example 10 has a lower than claimed TmII. However, this polymer is not identical to the polymer disclosed by the cited reference. There is no showing anywhere on the record that the polymers disclosed in the cited reference and which contain as little as 0.1 % of hydrogenated monomer and as little as 10 % of ethylene.

The arguments regarding rejection of claims under 35 USC 103 are, again, based on the features NOT claimed in the instant claims, i.e., properties of characteristics of the E/CTFE copolymer/CTFE homopolymer compositions.

The examiner discussed the limitations of the instant claims and the scope of the **claimed invention** in three consecutive office actions and pointed out REPEATEDLY that the invention as claimed does not require the presence of a second polymer as CLEARLY indicated by the claim language OPIONALLY with respect to the CTFE homopolymer. Once again, the examiner states for the record that arguments based on any properties or characteristics of composition that, in addition to E/CTFE necessarily contains CTFE homopolymer are irrelevant to the claimed invention and repeating those arguments **does not and will not** advance the prosecution of this application.

#### ***Allowable Subject Matter***

Claim12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the prior art reference disclose the process to obtain the claimed polymer composition (with all of the limitations of the composition as per claim 1) via a process that comprises the steps of claim 12. See also discussion in the Office action dated 11-12-2004.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel

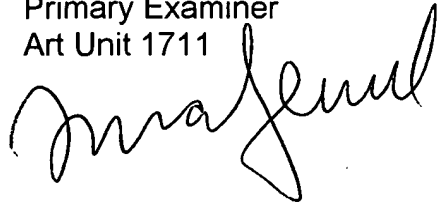


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ISZ

Primary Examiner  
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A handwritten signature in black ink, appearing to read "M. J. Smith", written over the printed name of the Primary Examiner.